



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,685	03/29/2001	Charles Scott Carmody	26283-4	4203

22493 7590 07/13/2005

BOARDMAN, SUHR, CURRY & FIELD LLP  
ATTN: IP PRACTICE GROUP  
1 SOUTH PINCKNEY STREET, FOURTH FLOOR  
P.O. BOX 927  
MADISON, WI 53701-0927

EXAMINER

STIMPAK, JOHNNA

ART UNIT	PAPER NUMBER
----------	--------------

3623

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/821,685

Applicant(s)

CARMODY, CHARLES SCOTT

Examiner

Johnna R. Stimpak

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The following is a final office action upon examination of application number 09/821,685. Claims 1-20 are pending and have been examined on the merits discussed below.

#### ***Response to Arguments***

2. Applicant's arguments filed 4/14/05 have been fully considered but they are not persuasive. Applicant states the method of claim 1 involves indirect communication via the recited host computer system, however, it is noted that the features upon which applicant relies are not recited in the rejected claim. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). As claimed, the host computer may be part of the main service provider company wherein service requests are received and assigned to individual service providers.
3. Regarding the new added claims 2-20, new rejections have been composed below.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berman et al, US 5,995,939.

Art Unit: 3623

As per claim 1 (currently amended), Berman et al teaches receiving at a host computer system, service requests (column 3, lines 40-48 – the system includes a client system and sponsor system and mail server system; service requests are entered or received which are electronically mailed to the sponsor system to be fulfilled); recording on the host computer system, which one of a plurality of service providers is assigned to each of the service requests (column 4, lines 3-24 – the appropriate service is provider is emailed regarding the service request); for each assigned service provider, having the host computer system notify the assigned service provider of each service request assigned to the service provider (column 4, lines 3-24 – the appropriate service is provider is emailed regarding the service request); and from each assigned service provider, receiving at the host computer system a service report describing services performed in response to each service request assigned to the service provider (column 4, lines 25-32 – the service provider processes the service request and a fulfilled service request message is emailed back to the original requestor to indicate completion). Berman et al does not explicitly teach the service requests pertaining to private onsite wastewater treatment systems; however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP § 2106.

Art Unit: 3623

As per claim 2 (new), Berman et al teaches providing the host computer system, a separate notification site for each assigned service provider (column 4, lines 60-67 – each service provider has a mail server provider by a commercial Internet provider); and notifying each service provider of service requests assigned to the service provider via the service providers notification site (column 3, lines 40-48 - service requests are entered or received which are electronically mailed to the sponsor system to be fulfilled).

As per claim 3 (new), Berman et al teaches the notification site is a web page hosted on the computer system (column 4, lines 60-67 – each service provider has a mail server provider by a commercial Internet provider).

As per claims 8, 9 and 10, they are the system for performing the method of claims 1, 2 and 3 respectively. Since Berman et al teaches a computer system, the same rejection as applied to claims 1, 2 and 3 also applies to claims 8, 9 and 10.

6. Claims 4-6, 11-15 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berman et al, US 5,995,939, in view of the Environmental Protection Agency's Envirofacts Warehouse, hereinafter, EPA.

As per claim 4, Berman et al does not explicitly teach providing the host computer system with access to a permit database of private onsite wastewater treatment systems for which permits have issued; and having the host computer search the permit database to determine if a private onsite wastewater treatment system for which a service request is received is included in the permit database. However, the EPA offers a database search tool on the Internet wherein a user can search through issued permits regarding wastewater systems. Since Berman et al's

Art Unit: 3623

system is generic to any type of service industry wherein a service request is assigned to an appropriate service provider, and could therefore obviously be used for wastewater treatment service requests, and also makes use of the Internet it would have been obvious to incorporate a permit database search since it is well known in the utility art that permits must be issued for wastewater treatment facilities in order to comply with government regulations. This would make the process of fulfilling service requests more efficient since the permit or lack thereof could easily be retrieved. Berman et al does not explicitly teach having the host computer system notify an appropriate governmental agency if the private onsite wastewater treatment system is not included in the permit database, however since it would be obvious to modify Berman et al to include permit database search capabilities as explained above, it would have been obvious to one of ordinary skill in the art to automate the manual process of notifying an appropriate government agency if no permit exists since it has generally been recognized that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

As per claim 5, The combination of Berman et al and EPA does not explicitly teach providing on the host computer system, a notification site corresponding to the appropriate government agency; and sending a notification to the appropriate governmental agency's notification site if the private onsite wastewater treatment system is not included in the permit database, however, based on the rejection to claim 4 above, and in view of the obvious modification of the combination of Berman et al and EPA to include database permit searches, it would have been obvious to one of ordinary skill in the art to include notification to be sent to an

Art Unit: 3623

appropriate government agency to notify them that a treatment plant is not included in the database since it is required by law that in order for a treatment plant to exist, permits must be obtained. It would be obvious to automate the notification by utilizing an Internet site since it has been recognized that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

As per claim 6, The combination of Berman et al and EPA does not explicitly teach the notification site is a web page hosted by the host computer system, however, based on the rejection to claim 4 above, and in view of the obvious modification of the combination of Berman et al and EPA to include database permit searches, it would have been obvious to one of ordinary skill in the art to include notification to be sent to an appropriate government agency to notify them that a treatment plant is not included in the database since it is required by law that in order for a treatment plant to exist, permits must be obtained. It would be obvious to automate the notification by utilizing an Internet site since it has been recognized that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

As per claims 11, 12, 13 and 15, they are collectively the system for performing the method of claim 4. Since Berman et al teaches a computer system and since the EPA's Environfacts is computer based, the same rejection as applied to claim 4 is also applied to claims 11, 12 and 13.

As per claim 14, it is the system for performing the method of claim 5. Since Berman et al teaches a computer system and since the EPA's Environfacts is computer based, the same rejection as applied to claim 5 is also applied to claim 14.

As per claim 20, Berman et al teaches a service provider database accessible by the host computer system, including a record of the providers providing service (column 3, lines 40-48 – the system includes a client system and sponsor system and mail server system; service requests are entered or received which are electronically mailed to the sponsor system to be fulfilled); and a service history database accessible by the host computer system, wherein the service history includes a service record (column 7, lines 23-27 – once the service request is fulfilled, a database update is performed, updating the service record). While Berman et al does not explicitly teach data regarding a wastewater treatment plant, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP § 2106. Berman et al does not explicitly teach a permit database accessible by the host computer system, wherein in the permit database includes a record of each of the plurality of private onsite wastewater treatment systems for which a permit has been issued. EPA teaches a permit database accessible by the host computer system, wherein the permit database includes a record of each of the plurality of private onsite wastewater treatment systems for which a permit has



Art Unit: 3623

been issued (a database search tool on the Internet wherein a user can search through issued permits regarding wastewater systems). However, the EPA offers a database search tool on the Internet wherein a user can search through issued permits regarding wastewater systems. Since Berman et al's system is generic to any type of service industry wherein a service request is assigned to an appropriate service provider, and could therefore obviously be used for wastewater treatment service requests.

7. Claims 7 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berman et al, US 5,995,939, in view of Snodgrass et al, "Taking infrastructure management systems into the next century":

As per claim 7, Berman et al assigning service requests to service providers does not explicitly teach providing the host computer system with access to a service history for each of the plurality of private onsite wastewater treatment systems; establishing a service event threshold for each of the plurality of private onsite wastewater treatment systems included in the service history database; having the host computer system monitor the service history database to determine if the service event threshold for any one of the plurality of private onsite wastewater treatment systems is exceeded; and having the host computer system notify an appropriate governmental agency if the service event threshold for any one of the plurality of private onsite wastewater treatment systems is exceeded. Snodgrass et al teaches an infrastructure management system to analyze historical data for public utilities such as water wherein preventative maintenance schedules for line repair and maintenance are monitored (page 2, bottom). The computerized maintenance management system (CMMS) schedules and tracks preventative maintenance tasks. Inherently the CMMS has thresholds establishing when

Art Unit: 3623

maintenance tasks are required and tracks their completion, which would also include notification of maintenance left incomplete. The incorporation of a maintenance threshold-monitoring feature into Berman et al's assignment of service requests would allow for a more efficient system of responding to service problems since it would be evident when certain services or maintenance is required.

As per claims 16, 17 and 18, they are collectively the system for performing the method of claim 7. Since Berman et al and Snodgrass both teach computer systems, the same rejection as applied to claim 7 is also applied to claims 16, 17 and 18.

As per claim 19, it is the system with a notification site to perform the method of claim 7. Since the combination of Berman et al and Snodgrass et al teach use of the Internet, it would have been obvious to one of ordinary skill in the art to include notification to be sent to an appropriate government agency to notify them that a treatment system service event threshold has been exceeded since it is required by law that treatment plant perform specific maintenance or service within specific time frames. It would be obvious to automate the notification by utilizing an Internet site since it has been recognized that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Smalley et al, US 6,256,640 – system for managing regulated entities

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johnna R. Stimpak whose telephone number is 571-272-6736. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 571-272-6729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3623

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JS

7/11/05



TARIQ R. HAFIZ  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600